

### REMARKS

This is in response to the office action dated August 8, 2007. The pending claims are 1-16, 19-32, 34-40, and 42-44. Claims 16 and 40 were withdrawn in the previous response, dated May 21, 2007, to the Examiner's restriction requirement, dated April 19, 2007. The Examiner has now indicated that the restriction with respect to claims 16 and 40 has been withdrawn, and that these claims will be examined. Accordingly, claims 16 and 40 are shown above as pending. Applicant has made no amendments to the claims in this response.

In the currently outstanding office action the Examiner finally rejected claims 1-12, 19-32, 34-38, and 42-44 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,578,363 to Finley et. al (hereinafter, "Finley") in view of U.S. Patent No. 4,464,428 to Ebert (hereinafter, "Ebert") and further in view of the Examiner's conclusion regarding inherent properties of closed cell foam. Finley discloses a multi-layered flooring composite for use over a subfloor layer. Finley does not expressly disclose the characteristics of the foam layer.

Ebert discloses a closed cell foamed material of polypropylene or polyethylene having interior canals sliced through the foam cells. Ebert, column 5, lines 5-7. Ebert does not disclose an acoustic layer including a plurality of discrete beads of substantially elastic, resilient material wherein portions of adjacent beads abut one another and other portions of said adjacent beads are spaced from each other to create spaces therebetween and wherein substantially all of said adjacent beads are integrally joined together at the abutting portions thereof.

To establish a prima facie case of obviousness, the prior art reference (or references when combined) must teach or suggest all the claim limitations. MPEP § 2143. The combination of Findley and Ebert does not teach all the claim limitations. The combination does not include a structure where portions of adjacent beads are spaced from each other to create spaces therebetween. Therefore, a prima facie case of obviousness has not been established.

The Examiner further stated that the claim limitation of spacing between portions of the beads is an inherent property of a closed cell foam. Applicant respectfully disagrees.

A reading of Ebert shows that a closed cell foamed material is a densely-packed material with low permeability to heat, moisture and sound. The properties of the closed cell foam that Ebert discusses are contrary to the Examiner's claim that an inherent property of a closed cell foam includes "portions of said adjacent beads are spaced from each other to create spaces." In discussing closed cell foamed material, Ebert states that "these webs of foamed material exhibit the disadvantage of possessing low permeability to heat, moisture and sound." Ebert, column 1, lines 24-25. Ebert teaches a method of increasing the permeability of closed cell foam material. Ebert states that the difficulty in increasing the permeability of the closed cell foamed material exists because "[e]ven where it is possible to arrange that the web of foamed material originally contain alterations designed to improve these properties, the application of heat and pressure in forming the finished web results in a densification of the pore structure which frequently disadvantageously affects the originally set properties." Ebert, column 1, lines 30-36. Two properties of the closed cell foam that Ebert discusses, first, the exhibited low permeability to heat, moisture and sound and second, the densification of the pore structure, are contrary to the Examiner's claim that an inherent property of a closed cell foam includes "portions of said adjacent beads are spaced from each other to create spaces." A foam in which portions of said adjacent beads are spaced from each other to create spaces therebetween would not possess a low permeability to moisture, and would not have a dense pore structure. As Ebert clearly shows, a closed cell foam is a densely-packed material with low permeability to heat, moisture and sound.

To establish a prima facie case of obviousness, the prior art reference (or references when combined) must teach or suggest all the claim limitations. MPEP § 2143. Since the combination of Findley and Ebert does not teach all the claim limitations, a prima facie case of obviousness has not been established. The Examiner's statement regarding the supposed inherent property of closed cell foams is

unsupported. The cited Ebert reference fails to teach spaces between the beads. The examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art. MPEP § 2112. The Examiner must provide a reason why a person skilled in the art would incorporate the alleged inherent property into the combination of Finley and Ebert. To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Id. Thus, Applicant respectfully requests that the Examiner withdraw the rejection under 35 U.S.C. § 103(a) of claims 1-12, 19-32, 34-38, and 42-44.

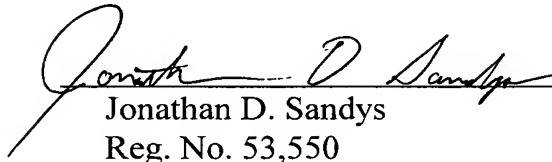
Claims 1 and 31 are the independent claims, and the objection to these claims has been traversed. Claims 2-16, 19-30, 32, 34-40, and 42-44 are dependent upon independent claim 1 or 31, and include all of the limitations recited therein. Accordingly, for the reasons given above, Applicant also believes that claims 2-16, 19-30, 32, 34-40, and 42-44 are patentable over the cited references and respectfully request that the Examiner withdraw her rejection of the claims.

In the currently outstanding office action the Examiner finally rejected claims 13-16 and 39-40 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,578,363 to Finley et. al (hereinafter, "Finley") in view of U.S. Patent No. 4,464,428 to Ebert (hereinafter, "Ebert") in view of U.S. Patent No. 6,189,279 to Fiechtl and further in view of the Examiner's conclusion regarding inherent properties of closed cell foam.

Claims 13-16 depend from independent claim 1, and claims 39-40 depend from independent claim 31. As discussed above, the limitations of independent claims 1 and 31 are not properly met by the combination of Finley and Ebert. Dependent claims 13-16 and 39-40 include all of the limitations recited in claim 1 or 31. Accordingly, for the reasons given above, Applicant believes that claims 13-16 and 39-40 are patentable over the cited references and respectfully request that the Examiner withdraw her rejection of the claims.

In view of the above remarks, it is believed that the application is in condition for allowance.

Respectfully submitted,

  
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